

Customer No. 24498
Attorney Docket No. PU030177 US
Office Action Date: December 26, 2007

RECEIVED
CENTRAL FAX CENTER
MAR 14 2008

Remarks/Arguments

The Office Action mailed on September 20, 2007 has been reviewed and carefully considered.

Claim 9 has been amended. Claim 13 remains canceled without prejudice. Claims 1-12 and 14-21 are now pending in this application. No new matter has been introduced by the amendments.

Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested. It should be noted that the Applicants are not conceding in this application that the amended claims in their prior form are not patentable over the art cited by the Examiner, as the present claim amendments have been made only to facilitate expeditious prosecution of the application. The Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications.

Rejections under 35 U.S.C. §103(a)

Claims 1-4, 6-7, 9-12 and 15-21 currently stand rejected under 35 U.S.C. §103(a) in view of United States Patent Application Publication No. 2004/0264395 (hereinafter 'Hsu') and the Applicants' purportedly admitted prior art (hereinafter 'PAPA'). Applicants respectfully request reconsideration of the Examiner's §103(a) rejection in light of the above amendments, and the following comments.

Claim 1 of the present application recites:

A method, comprising:

scanning, by a wireless local area network scanner in a wireless device, to detect the presence of a wireless local area network WLAN;

detecting the presence of said wireless local area network by employing said wireless local area network scanner to identify energy fluctuations without a wireless local area network baseband circuit being activated to process data;

contacting a base station of said wireless local area network by the wireless local area network baseband circuit in said wireless device in response to detection of said wireless local area network to request location of said base station; and

receiving location of said wireless local area network.

As discussed in the response to the Office Action dated September 20, 2007, Hsu discloses a wireless device that utilizes a tuner to scan for a WLAN beacon (see, e.g. Hsu, paragraphs 64, 78). However, Hsu fails to discuss any specific details whatsoever regarding how the beacon is detected. Accordingly, Hsu does not disclose or render obvious the feature of

Customer No. 24498
Attorney Docket No. PU030177 US
Office Action Date: December 26, 2007

detecting the presence of a WLAN by identifying energy fluctuations without a WLAN baseband circuit being activated to process data.

In support of the rejection of claim 1, the Examiner asserts that PAPA indicates that it is well-known to one of ordinary skill in the art that a WLAN baseband circuitry need not be activated to detect the presence of a WLAN. Specifically, the Examiner cites the following portion of the Applicant's Specification in support of the assertion:

The frequency reference accuracy specified in WLAN standards (e.g., $\pm .25$ ppm as specified in the IEEE 802.11b standard) can allow the PLL circuit 314 to operate without automatic frequency control (AFC) provided by the WLAN baseband circuitry. As such, the WLAN baseband circuitry 208 does not have to be activated to detect the presence of the WLAN, thereby conserving power and saving battery life in the mobile device.

(Specification, p. 10, lines 15-18)

The Examiner seems to interpret the above-recited portion of the Specification (PAPA) to mean that IEEE 802.11b standards state that phase-locked loop circuits may operate without automatic frequency control provided by the WLAN baseband circuitry (see Office Action dated December 26, 2007, p. 4, paragraphs 1-2). However, regarding known prior art, PAPA simply indicates that standard frequency reference accuracies themselves are known (' $\pm .25$ ppm as specified in the IEEE 802.11b standard'). PAPA does not state that operating a PLL without automatic frequency control is well known in the art. Rather, PAPA demonstrates that the Applicants have recognized that the WLAN baseband circuitry need not be activated to detect the presence of a WLAN because the PLL circuit may operate with such frequency reference accuracies without automatic frequency control provided by the WLAN. Nowhere do the Applicants admit that such features are prior art.

Therefore, the description in the Specification concerning PLL circuit operation without AFC cannot be relied upon in the rejection of claim 1. See MPEP 2141 (stating that patentability must be assessed 'at the time the invention was made' to avoid impermissible hindsight) (citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). See also MPEP 2142 (stating that 'knowledge of applicant's disclosure must be put aside' in determining obviousness). Accordingly, Hsu in view of PAPA does not render claim 1 obvious for at least the reasons discussed above. Thus, claim 1 is believed to be patentable. Moreover, claims 2-4, 6, 7 are believed to be patentable over Hsu in view of PAPA due at least to their dependencies from claim 1.

Customer No. 24498
Attorney Docket No. PPU030177 US
Office Action Date: December 26, 2007

With regard to the patentability of claim 9, claim 9 recites, inter alia:

detecting the presence of said wireless local area network by identifying energy fluctuations of a wireless local area network signal without performing carrier recovery to detect the presence of said wireless local area network.

As discussed above, Hsu does not provide any specific details concerning how WLAN beacons are detected. Accordingly, Hsu does not disclose or remotely suggest detecting the presence of a WLAN by identifying energy fluctuations without performing carrier recovery. Furthermore, as discussed above, PAPA may not be relied upon to render claim 9 obvious. Thus, claim 9 is believed to be patentable. Furthermore, claims 10-12 and 15 are also believed to be patentable due at least to their dependencies from claim 9.

Furthermore, claim 16 is not obvious over Hsu in view of PAPA, as claim 16 includes similar features discussed above regarding claim 1. Claim 16 recites, inter alia:

detecting presence of said wireless local area network by employing said wireless local area network scanner to identify energy fluctuations without a wireless local area network baseband circuit being activated to process data.

Thus, claim 16 is believed to be patentable for at least the reasons discussed above with regard to claim 1. In addition, claims 17-21 are believed to be patentable due at least to their dependencies from claim 16.

As such, withdrawal of the rejection is respectfully requested.

Claim 5 currently stands rejected under §103(a) in view of Hsu in view of PAPA in further view of United States Patent Application Publication No. 2004/0264395 (hereinafter 'Rao'). Applicants respectfully request reconsideration of the Examiner's §103(a) rejection in light of the following comments.

Claim 5 is dependent from claim 1 and thus also includes, inter alia, the feature of "detecting the presence of said wireless local area network by employing said wireless local area network scanner to identify energy fluctuations without a wireless local area network baseband circuit being activated to process data." As discussed above, Hsu does not disclose or render obvious at least this feature. Furthermore, as discussed above, PAPA cannot be relied upon in rejecting claims of the present application.

Customer No. 24498
Attorney Docket No. PU030177 US
Office Action Date: December 26, 2007

In addition, Rao does not disclose or render obvious the above recited feature of claim 5. Rao is directed to methods and apparatuses for automatically configuring a wireless network client by identifying wireless local network access points upon detecting a wireless local network message (see, e.g., Rao, paragraph 8). However, Rao merely states that WLAN access points are discovered and a broadcast message is detected by the wireless client (see, e.g., Rao, paragraphs 43 and 53). No specific details concerning how the WLAN access points are detected are provided by Rao in any way. Moreover, the reference certainly does not disclose or remotely suggest that a baseband circuit is deactivated while identifying a WLAN broadcast message to detect the presence of a wireless network.

Accordingly, claim 5 is believed to be in condition for allowance at least because Rao and Hsu, taken singly or in combination, fail to disclose or render obvious the feature of detecting the presence of a wireless local area network by identifying energy fluctuations without a wireless local area network baseband circuit being activated to process data.

Claims 8 and 14 currently stand rejected under 35 U.S.C. §103(a) in view of Hsu in further view of PAPA and in further view of United States Patent Application Publication No. 2003/0134650 (hereinafter 'Sundar'). Applicants respectfully request reconsideration of the Examiner's §103(a) rejection in light of the above amendments, and the following comments.

Claim 8 is dependent on claim 1 and includes, inter alia, the feature of "detecting the presence of said wireless local area network by employing said wireless local area network scanner to identify energy fluctuations without a wireless local area network baseband circuit being activated to process data," as described above. In addition, claim 14 is dependent on claim 9 and thereby includes, inter alia, "detecting the presence of said wireless local area network by identifying energy fluctuations of a wireless local area network signal without performing carrier recovery to detect the presence of said wireless local area network."

Sundar is directed to interworking a mobile station between WWANs and WLANs. As discussed more fully in response to the Office Action dated Sepetember 20, 2007, Sundar discloses inferring the presence of a wireless LAN by detecting RF energy in the permitted 802.11b/a spectrum and processing a beacon frame to obtain an SSID (see, e.g., Sundar, paragraphs 55-58). Thereafter, the obtained SSID is compared to a list of SSIDs and if there is a match, the mobile station infers the prcsence of a valid WLAN (see, e.g., Sundar, paragraph 58).

Customer No. 24498
Attorney Docket No. PU030177 US
Office Action Date: December 26, 2007

First, Sundar fails to disclose identifying energy fluctuations to detect the presence of a wireless LAN. As stated above, Sundar discloses identifying whether RF energy within certain frequencies are present. In contrast, according to one or more implementations of the present principles, the presence of a wireless LAN is detected by identifying energy fluctuations associated with wireless LAN activity (see, e.g., Specification, p. 8, lines 12-23; p. 9, line 20 to p. 10, line 20; FIGS. 7-8). For example, energy fluctuations may correspond to periodic beacons transmitted at a programmable rate by the WLAN, which may be identified to distinguish the WLAN from other radio frequency noise sources (see, e.g., Specification, p. 8, lines 12-23; p. 9, line 20 to p. 10, line 20; FIGS. 7-8) (describing the nature of energy fluctuations associated with WLAN beacons and their detection). Identifying energy fluctuations in accordance with aspects of the present principles provides a more accurate method of WLAN detection that is not disclosed or rendered obvious by Sundar, which merely describes detecting whether RF energy within certain frequencies are present.

Second, Sundar also fails to disclose or render obvious the claim 8 feature of detecting the presence of a WLAN without a wireless local area network baseband circuit being activated to process data. As discussed above, Sundar detects the presence of a valid WLAN by processing a beacon to extract an SSID. Extraction of an SSID necessarily entails the activation of a WLAN baseband circuit to process data. Thus, Sundar fails to disclose or remotely render obvious detecting the presence of a WLAN without a wireless local area network baseband circuit being activated to process data.

Similarly, Sundar also fails to disclose or render obvious the claim 14 feature of detecting the presence of a WLAN without performing carrier recovery. Carrier recovery is performed to extract data from a WLAN carrier signal. Accordingly, because the mobile station of Sundar extracts an SSID from a WLAN beacon, the mobile station also necessarily performs carrier recovery to detect the presence of a WLAN. Therefore, Sundar fails to disclose or render obvious detecting the presence of a WLAN without performing carrier recovery.

Thus, claims 8 and 14 are believed to be in condition for allowance for at least the reasons stated above.

Customer No. 24498
Attorney Docket No. PU030177 US
Office Action Date: December 26, 2007

RECEIVED
CENTRAL FAX CENTER
MAR 14 2008

Conclusion

In view of the foregoing, applicants respectfully requests that the rejections of the claims set forth in the Office Action of December 26, 2007 be withdrawn, that pending claims 1-12 and 14-21 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's representatives Deposit Account No. 07-0832.

Respectfully submitted,

gjh
Jeffrey D. Hale
Registration No. 40,012
609-734-6444

Dated: 3/14/08

Thomson Licensing LLC
2 Independence Way, Suite 200
P.O. Box 5312
Princeton, NJ 08543-5312